

Application No.: 09/843,051
Amendment Dated: June 15, 2005

REMARKS

Reconsideration of the merits of the application is respectfully requested in light of the remarks that follow.

Rejection over Schaer, U.S. Patent No. 6,251,107 under 35 USC §102

Claims 1, 2, 4, 8, and 10-13 have been rejected under 35 USC §102(e) as allegedly being anticipated by Schaer. Applicants respectfully traverse the rejection.

Claim 1 has been amended herein to specify that the electrode connector "is electrically and mechanically connected to the coil electrode". The March 15, 2005 final office action indicated that the argument that Applicant's connector provides electrical and mechanical connection for the wire coil "are not persuasive since those limitations are not claimed". Applicant respectfully asserts that since those limitations are now claimed, they are now persuasive, and that this rejection should therefore be withdrawn.

Rejection over Speicher et al., US Patent No. 4,603,705 under 35 USC § 102 or § 103

Claims 1, 2, 4, and 11-13 have been rejected under 35 USC §102(b) as allegedly being anticipated by or alternatively under 35 USC § 103(a) as obvious over Speicher et al. Claims 3 and 8-10 are also rejected under 35 U.S.C. § 103(a) as being unpatentable over Speicher et al. Applicants respectfully traverse the rejection.

The Examiner asserts that a recitation of an intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Applicant respectfully asserts that the intended use does result in structural differences.

The pending claims include a recitation "for electrical stimulation of one or more sacral nerves of a human patient". This intended use does impart structural features to the claim. As seen in *New Perspectives in Sacral Nerve Stimulation* (cited in an attached Supplemental IDS), the area between the sacral foramina S1, S2, S3, and S4 are generally about 2-3 cm each (pg 11). Figure 2.7 also shows a lead that has been placed through S3 (pg 15). Figure 2.7 also provides a comparison of the distance between the S1, S2, and S3 foramen and the area beneath the sacrum that would be being simulated by the lead. From that comparison, it can be seen that a lead "for

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electrical stimulation of one or more sacral nerves of a human patient" would be about 6 cm to 9 cm (e.g. distance from S1 to S4) at the most. Therefore, the phrase "for electrical stimulation of one or more sacral nerves of a human patient" does provide structural features to the claim because it provides a maximum length of the area of stimulation.

Contrary to that, the lead of Speicher has electrodes that are spaced significantly farther apart so that the lead is "capable of delivering a high-energy discharge through a single catheter and immediately being able to effectively sense the heart's electrical activity through the same catheter" (col. 3, lines 19-23). The lead even includes further structures to maintain the spacing between the electrodes. "[T]ubing 46 provides for proper spacing between intermediate electrode 18 and proximal electrode 48. It is preferred that this distance be in the range of about 8 to 14 centimeters, with about 11 centimeters being optimal" (col. 6, lines 12-16). The necessity of this distance is discussed at column 6, line 62 through column 7, line 8, and is necessary so that rate sensing and low threshold pacing are performed on undamaged heart tissue (as can be caused by the higher voltage cardioversion).

As discussed above, the functional use recitation of "for electrical stimulation of one or more sacral nerves of a human patient" does provide structural features that distinguish it from the prior art.

The rejected claims would not be an obvious modification of Speicher because if Speicher were modified to decrease the distance between the electrodes, the lead would no longer work for its intended purpose. As stated in MPEP § 2143.01, "the proposed modification cannot render the prior art unsatisfactory for its intended purpose". Therefore, the device of Speicher does not render claims 1, 2, 4, and 11-13 obvious, because there is not motivation to modify the teachings of Speicher to result in the subject matter of claims 1, 2, 4, and 11-13.

In light of the remarks offered above, Applicant respectfully requests that the Examiner withdraw this rejection.

Claims 3 and 8-10 have been rejected under 35 USC § 103(a) as obvious over Speicher et al. Applicants respectfully traverse the rejection. Applicant reiterates the comments offered above and submits that the independent claim, claim number 1, which claims 3, and 8-10 are dependent on is not obvious, and therefore neither are claims dependent thereon. In light of the remarks offered above, Applicant respectfully requests that the Examiner withdraw this

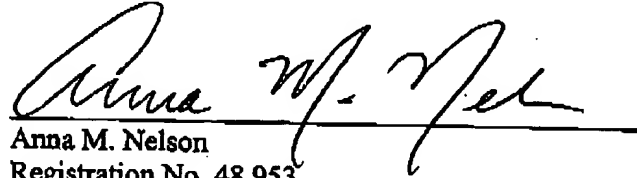
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rejection.

In view of the foregoing remarks, it is believed that the application is now in condition for allowance and notice of this, in the form of a notice of allowance is respectfully requested.

Respectfully submitted,

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